

REMARKS

Claims 1-16 were pending in the application. Applicants cancelled claims 1-8 without prejudice or disclaimer. Hence, claims 9-16 are pending in the application.

Applicants cancelled claims 1-8 so as to prosecute all program storage claims in one patent application. Applicants are not conceding in this application that cancelled claims 1-8 are not patentable over the art cited by the Examiner or are directed to non-statutory subject matter. Claims 1-8 were cancelled solely to facilitate expeditious prosecution of the remaining program storage claims (claims 9-16). Applicants respectfully reserve the right to pursue these (claims 1-8) and other claims in one or more continuation patent applications.

Claims 5-8 and 13-16 are rejected under 35 U.S.C. §112, first paragraph. Claims 1 and 9 are rejected under 35 U.S.C. §102(b). Claims 2-8 and 10-16 are rejected under 35 U.S.C. §103(a).

Applicants address these rejections below in connection with pending claims 9-16.

I. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 13-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Office Action (7/25/2008), page 3. In particular, the Examiner asserts that the claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *Id.* Further, the Examiner asserts that it is not clear, from either the Specification or the claims, how this matrix of weights as disclosed in claim 13 is determined. *Id.* Applicants respectfully traverse the assertion that claims 13-16 fail to comply with the written description requirement.

The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the Specification

accomplishes this is not material. *In re Herschler*, 591 F.2d 693, 700-01, 200 U.S.P.Q. 711, 717 (C.C.P.A. 1979); M.P.E.P. §2163-§2163.04.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q.2d 1429, 1438 (Fed. Cir. 2003). Applicants show possession of the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997).

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1962). However, the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that Applicants had possession of the claimed invention. M.P.E.P. §2163.

The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the Specification as filed. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976).

The Examiner asserts that the Specification does not describe how the matrix of weights, as disclosed in claim 13, is determined. Weights may be determined in any number of ways, including having it inputted by a user, which is known in the art. The Specification is to include a written description of the invention and to distinguish it from other inventions and from that what is old. M.P.E.P. §2163. However, it is not important as to the manner in determining weights and it is not

necessary for Applicants to explain each manner. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). There are certain aspects that do not need to be explained in full detail for the sake of brevity as well as to not cause confusion as to what is the invention. For example, suppose the invention were directed to a circuit and there is a statement about a power supply. Applicants should not be expected to explain how the power supply delivers current to the circuit. The reason is because this is known in the art and such explanation would result in confusion as to what is the invention. The Specification, in particular paragraph [0017], clearly provides sufficient detail about weighting that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The Examiner has not shown otherwise. Accordingly, the Specification describes the claimed invention of claims 13-16 in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. As a result, the Examiner has not met his initial burden in rejecting claims 13-16 under 35 U.S.C. §112, first paragraph.

II. REJECTIONS UNDER 35 U.S.C. §102(b):

The Examiner has rejected claim 9 under 35 U.S.C. §102(b) as being anticipated by Ostrowski et al. (U.S. Patent No. 6,301,516) (hereinafter "Ostrowski"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Ostrowski does not disclose "evaluating supplier metrics for customer interest categories to provide numerical values for a software product requirement" as recited in claim 9. The Examiner cites column 2, lines 1-4, 23-29 and 33-37 of Ostrowski as disclosing the above-cited claim limitation. Office Action (7/25/2008), page 5. Applicants respectfully traverse.

Ostrowski instead discloses that a quality matrix provides for tracking and assessing the relationship between critical to quality characteristics and key control

parameters within a level. Column 2, lines 1-4. Ostrowski further discloses that for each critical to quality characteristic 110 and each key control parameter 112, an interaction weight 116 is assigned representing the effect that a key control parameter 112 has on a critical to quality characteristic 110. Column 2, lines 23-27. Furthermore, Ostrowski discloses that a total score is generated for each key control parameter as shown in row 118. Column 2, lines 33-34.

Hence, Ostrowski discloses a quality matrix that provides for tracking and assessing the relationship between critical to quality characteristics and key control parameters within a level. Further, Ostrowski discloses assigning an interaction weight for each critical to quality characteristic and each key control parameter.

There is no language in the cited passages that discloses evaluating supplier metrics for customer interest categories. Neither is there any language in the cited passages that discloses evaluating supplier metrics for customer interest categories to provide numerical values for a software product requirement.

Thus, Ostrowski does not disclose all of the limitations of claim 9, and thus Ostrowski does not anticipate claim 9. M.P.E.P. §2131.

Applicants further assert that Ostrowski does not disclose "computing partial scores for the customer interest categories by weighting and summing the numerical values" as recited in claim 9. The Examiner cites column 2, lines 33-40 of Ostrowski as disclosing the above-cited claim limitation. Office Action (7/25/2008), page 6. Applicants respectfully traverse.

Ostrowski instead discloses that a total score is generated for each key control parameter as shown in row 118. Column 2, lines 33-34. Ostrowski further discloses that each interaction weight 116 may be assigned a numerical value. Column 2, lines 34-35. Furthermore, Ostrowski discloses that in the example shown in Figure 2, low has a value of 1, medium has a value of 3 and high has a value of 9. Column 2, lines 35-37. Additionally, Ostrowski discloses that to generate the total score for each key control parameter 112, the interaction weights 116 are multiplied by the critical to quality weights 114 along a column of the matrix and these products are summed. Column 2, lines 37-40.

Hence, Ostrowski discloses generating a total score for each key control parameter. Further, Ostrowski discloses that to generate the total score for each key control parameter, the interaction weights are multiplied by the critical to quality weights along a column of the matrix and these products are summed.

There is no language in the cited passages that discloses computing partial scores for the customer interest categories by weighting and summing the numerical values. Thus, Ostrowski does not disclose all of the limitations of claim 9, and thus Ostrowski does not anticipate claim 9. M.P.E.P. §2131.

Applicants further assert that Ostrowski does not disclose "determining an overall score for the software product requirement from the partial scores" as recited in claim 9. The Examiner cites column 2, lines 33-46 of Ostrowski as disclosing the above-cited claim limitation. Office Action (7/25/2008), page 6. Applicants respectfully traverse.

As discussed above, Ostrowski discloses that to generate the total score for each key control parameter, the interaction weights are multiplied by the critical to quality weights along a column of the matrix and these products are summed.

There is no language in the cited passage that discloses determining an overall score for the software product requirement from the partial scores. Thus, Ostrowski does not disclose all of the limitations of claim 9, and thus Ostrowski does not anticipate claim 9. M.P.E.P. §2131.

III. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 10 and 14 under 35 U.S.C. §103(a) as being unpatentable over Ostrowski in view of Ali et al. (U.S. Patent No. 6,351,680) (hereinafter "Ali"). The Examiner has further rejected claims 11-13 and 16 under 35 U.S.C. §103(a) as being unpatentable over Ostrowski. Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

- A. Claim 10 is patentable over Ostrowski in view of Ali for at least the reasons that claim 9 is not anticipated by Ostrowski.

Claim 10 recites the combinations of features of independent claim 9, and hence claim 10 is patentable over Ostrowski in view of Ali for at least the above-stated reasons that claim 9 is not anticipated by Ostrowski.

- B. Claims 11 and 12 are patentable over Ostrowski for at least the reasons that claim 9 is not anticipated by Ostrowski.

Claims 11 and 12 recite the combinations of features of independent claim 9, and hence claims 11 and 12 are patentable over Ostrowski for at least the above-stated reasons that claim 9 is not anticipated by Ostrowski.

- C. Claims 10 and 14 are patentable over Ostrowski in view of Ali.

1. Ostrowski and Ali, taken singly or in combination, do not teach at least the following claim limitations.

Applicants respectfully assert that Ostrowski and Ali, taken singly or in combination, do not teach or suggest "wherein the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability" as recited in claim 10 and similarly in claim 14. The Examiner cites "customer expectations" and column 2, lines 5-10 of Ostrowski as disclosing the claimed customer interest categories. Office Action (7/25/2008), page 12. The Examiner further cites element 102 of Figure 4A of Ali as disclosing the remaining elements. *Id.* Applicants respectfully traverse the assertion that Ostrowski and Ali, taken in combination, teach the above-cited claim limitation.

Ostrowski instead teaches that the critical to quality characteristics 110 are customer expectations. Column 2, lines 7-9.

The Examiner has not provided any evidence that customer expectations is the same as customer interest categories. How are expectations the same as an interest category? The Examiner has not provided any evidence that "customer expectations," as used in Ostrowski, refers to categories, such as capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that customer expectations, as taught in Ostrowski, is the same as customer

interest categories. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that customer expectations, as taught in *Ostrowski*, is the same as customer interest categories, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 10 and 14. M.P.E.P. §2112.

Furthermore, Ali instead teaches that at a first level, a system quality matrix 100 relates CTQ's 102 to KCP's 104. Column 2, lines 52-53. Further, Ali teaches lamp brightness and lamp life as examples of lamp product requirements as illustrated in Figure 4A.

There is no language in Ali that teaches that the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 10 and 14, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's reasoning for modifying Ostrowski with Ali to include the missing claim limitation of claims 10 and 14 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of

the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Ostrowski does not teach that customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, as recited in claim 10 and similarly in claim 14.¹ Office Action (7/25/2008), page 12. The Examiner asserts that Ali teaches the above-cited claim limitation. *Id.* The Examiner's reasoning for modifying Ostrowski with Ali is that "one of ordinary skill in the art would have recognized that the results of the combination were predictable." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 10 and 14.

As indicated in M.P.E.P. §2143, the "combining prior art elements according to known methods to yield predictable results" rationale requires the Examiner to: (1) find that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) find that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) find that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Examiner has not made any findings that show that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Further, the Examiner has

¹ The portion of claim 10 underlined corresponds to the language of claim 10 and similarly claim 14 that the Examiner asserts is not taught by Ostrowski.

not made any findings to show that one of ordinary skill in the art could have combined the elements as claimed by known methods. Neither has the Examiner shown that each element merely performs the same function as it does separately. Additionally, the Examiner has not shown that one of ordinary skill in the art would have recognized that the results of the combination were predictable. Hence, the Examiner's rationale does not support a finding of a *prima facie* case of obviousness in rejecting claims 10 and 14.

D. Claims 11-13 and 15-16 are patentable over Ostrowski.

1. Ostrowski does not teach at least the following claim limitations.

a. Claims 11 and 15 are patentable over Ostrowski.

Applicants respectfully assert that Ostrowski does not teach "wherein the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement" as recited in claim 11 and similarly in claim 15. The Examiner cites "key control parameters" and column 2, lines 16-17 of Ostrowski as disclosing the claimed supplier metrics. Office Action (7/25/2008), page 7. The Examiner further cites element 104 of Figure 4A of Ali as disclosing the remaining elements. *Id.* Applicants respectfully traverse the assertion that Ostrowski and Ali, taken in combination, teach the above-cited claim limitation.

Ostrowski instead discloses that the key control parameters 112 are product requirements. Column 2, lines 10-11.

The Examiner has not provided any evidence that key control parameters, which refer to product requirements as illustrated in Figure 2 of Ostrowski, are the same as supplier metrics. The Examiner has not provided any evidence that "key control parameters," as used in Ostrowski, refer to metrics, such as market penetration, priority as determined by a customer, revenue potential and state of technology advancement. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that key control parameters, as taught in Ostrowski, is the same as supplier metrics. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat.

App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that key control parameters, as taught in Ostrowski, is the same as supplier metrics, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 11 and 15. M.P.E.P. §2112.

Furthermore, Ali instead teaches that at a first level, a system quality matrix 100 relates CTQ's 102 to KCP's 104. Column 2, lines 52-53. Further, Ali teaches lamp brightness and lamp life as examples of lamp product requirements as illustrated in Figure 4A.

There is no language in Ali that teaches that the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 11 and 15, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

b. Claim 12 is patentable over Ostrowski.

The Examiner admits that Ostrowski does not teach "averaging non-zero partial scores" as recited in claim 12. Office Action (7/25/2008), page 8. The Examiner asserts that is known in the art to average scores. *Id.* Applicants though respectfully traverse the assertion that it is known in the art for averaging non-zero partial scores and respectfully request the Examiner to provide a reference that teaches averaging non-zero partial scores pursuant to M.P.E.P. §2144.03.

c. Claim 13 is patentable over Ostrowski.

Applicants respectfully assert that Ostrowski does not teach "forming an N by M matrix A of numerical values of supplier metrics for customer interest categories of a software product requirement, where N is a number of supplier metrics and M is a number of customer interest categories" as recited in claim 13. The Examiner cites column 1, lines 67-68 and column 2, lines 1-11 and 16-17 of Ostrowski as teaching

the above-cited claim limitations. Office Action (7/25/2008), pages 8-9. Applicants respectfully traverse.

Ostrowski instead teaches that Figure 2 depicts a quality matrix shown generally at 100. Column 1, line 66. Ostrowski further teaches that the quality matrices provide for tracking and assessing the relationship between critical to quality characteristics and key control parameters within a level and between levels of the design process. Column 2, lines 1-4. Additionally, Ostrowski teaches that the quality matrix is based on market data and that the critical to quality characteristics 110 are customer expectations. Column 2, lines 8-10. Furthermore, Ostrowski teaches that the matrix 100 may be expanded by adding critical to quality characteristics and/or key control parameters. Column 2, lines 16-17.

Hence, Ostrowski teaches a quality matrices that provides for tracking and assessing the relationship between critical to quality characteristics and key control parameters within a level and between levels of the design process.

There is no language in the cited passages that teaches forming an N by M matrix A of numerical values of supplier metrics for customer interest categories of a software product requirement, where N is a number of supplier metrics and M is a number of customer interest categories.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 13, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Ostrowski does not teach "multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores" as recited in claim 13. The Examiner admits that Ostrowski does not explicitly teach the above-cited claim limitation but takes official notice that a matrix can be made to be any size and that matrix operations are old and well known. Office Action (7/25/2008), page 9. Applicants respectfully traverse the implied assertion that it is well known in the art to multiply the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores. Applicants respectfully request the Examiner to provide a reference

that teaches multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores pursuant to M.P.E.P. §2144.03.

Further, the Examiner cites matrix 100 of Figure 2 of Ostrowski in connection with the above-cited claim limitation. There is no depiction in Figure 2 of Ostrowski that teaches multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 13, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Ostrowski does not teach "determining an overall score for the software product requirement from diagonal elements of the matrix P" as recited in claim 13. The Examiner admits that Ostrowski does not explicitly teach the above-cited claim limitation but takes official notice that it is old and well known in the art to determine values from the diagonal of a matrix. Office Action (7/25/2008), page 10. Applicants respectfully traverse the implied assertion that it is well known in the art to determine an overall score for the software product requirement from diagonal elements of the matrix P. Applicants respectfully request the Examiner to provide a reference that teaches determining an overall score for the software product requirement from diagonal elements of the matrix P pursuant to M.P.E.P. §2144.03.

2. Examiner's reasoning for modifying Ostrowski with Ali to include the missing claim limitation of claims 11 and 15 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of

each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Ostrowski does not teach that supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement, as recited in claim 11 and similarly in claim 15.² Office Action (7/25/2008), page 7. The Examiner asserts that Ali teaches the above-cited claim limitation. *Id.* The Examiner's reasoning for modifying Ostrowski with Ali is that "one of ordinary skill in the art would have recognized that the results of the combination were predictable." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 11 and 15.

As indicated in M.P.E.P. §2143, the "combining prior art elements according to known methods to yield predictable results" rationale requires the Examiner to: (1) find that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) find that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) find that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under

² The portion of claim 11 underlined corresponds to the language of claim 11 and similarly claim 15 that the Examiner asserts is not taught by Ostrowski.

consideration, to explain a conclusion of obviousness. The Examiner has not made any findings that show that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Further, the Examiner has not made any findings to show that one of ordinary skill in the art could have combined the elements as claimed by known methods. Neither has the Examiner shown that each element merely performs the same function as it does separately. Additionally, the Examiner has not shown that one of ordinary skill in the art would have recognized that the results of the combination were predictable. Hence, the Examiner's rationale does not support a finding of a *prima facie* case of obviousness in rejecting claims 11 and 15.

3. Examiner's reasoning for modifying Ostrowski to include the missing claim limitation of claim 12 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Ostrowski does not teach "averaging non-zero partial scores" as recited in claim 12. Office Action (7/25/2008), page 8. The Examiner's reasoning for modifying Ostrowski to include this missing claim limitation is that "the claimed invention is merely a combination of old elements, and the combination would have been a predictable result of the combination to remove any undue influence of any one category when determining a total score by finding an average." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claim 12.

As indicated in M.P.E.P. §2143, the "combining prior art elements according to known methods to yield predictable results" rationale requires the Examiner to: (1) find that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) find that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) find that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Examiner has not made any findings that show that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Further, the Examiner has not made any findings to show that one of ordinary skill in the art could have combined the elements as claimed by known methods. Neither has the Examiner shown that each element merely performs the same function as it does separately. Additionally, the Examiner has not shown that one of ordinary skill in the art would have recognized that the results of the combination were predictable. Hence, the Examiner's rationale does not support a finding of a *prima facie* case of obviousness in rejecting claim 12.

4. Examiner's reasoning for modifying Ostrowski to include the first missing claim limitation of claim 13 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Ostrowski does not teach "multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores" as recited in claim 13. Office Action (7/25/2008), page 9. The Examiner's reasoning for modifying Ostrowski to include this missing claim limitation is that "it would have been a predictable result of this modification to Ostrowski to give the user of Ostrowski flexibility in determining how many weights to use, and to use any outcome of matrix operations, wither it is vector, matrix or scalar multiplication, to determine scores." The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claim 13.

As indicated in M.P.E.P. §2143, the "combining prior art elements according to known methods to yield predictable results" rationale requires the Examiner to: (1)

find that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) find that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) find that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Examiner has not made any findings that show that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Further, the Examiner has not made any findings to show that one of ordinary skill in the art could have combined the elements as claimed by known methods. Neither has the Examiner shown that each element merely performs the same function as it does separately. Additionally, the Examiner has not shown that one of ordinary skill in the art would have recognized that the results of the combination were predictable. Hence, the Examiner's rationale does not support a finding of a *prima facie* case of obviousness in rejecting claim 13.

Furthermore, the Examiner has not provided any rational underpinning as to how the Examiner derived his motivation for modifying Ostrowski to include the above-cited missing claim limitation. The Examiner simply states "it would have been a predictable result of this modification to Ostrowski to give the user of Ostrowski flexibility in determining how many weights to use, and to use any outcome of matrix operations, wither it is vector, matrix or scalar multiplication, to determine scores" as reasoning for modifying Ostrowski to include the above-cited claim limitation. While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Ostrowski to include the above-cited missing claim limitation. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). The Examiner appears to be relying upon his own subjective opinion which is insufficient

to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's reasoning for modifying Ostrowski to include the missing claim limitation of claim 13 is insufficient to support a *prima facie* case of obviousness for rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner's reasoning ("it would have been a predictable result of this modification to Ostrowski to give the user of Ostrowski flexibility in determining how many weights to use, and to use any outcome of matrix operations, wither it is vector, matrix or scalar multiplication, to determine scores") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ostrowski to include the above-indicated missing claim limitation of claim 13. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Ostrowski addresses improving the process in using the house of quality design process. Column 1, lines 19-32. The Examiner has not provided any reasons as to why one skilled in the art would modify Ostrowski (which improves the process in using the house of quality design process) to multiply the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores (missing claim limitation). The Examiner's rationale ("it would have been a predictable result of this modification to Ostrowski to give the user of Ostrowski flexibility in determining how many weights to use, and to use any outcome of matrix operations, wither it is vector, matrix or scalar multiplication, to determine scores") does not provide such reasoning.

Why would the reason to modify Ostrowski (whose purpose is to improve the process in using the house of quality design process) to multiply the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores (missing claim limitation) be to give the user flexibility in

determining how many weights to use? Ostrowski is not concerned with using weights. The Examiner cannot completely ignore the teachings of Ostrowski in concluding it would have been obvious to modify Ostrowski to include the missing claim limitation of claim 13.³

Further, what is the rational connection between multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix $P=WA$, to provide partial scores (missing claim limitation) and giving the user flexibility in determining how many weights to use (Examiner's reasoning)?

Hence, the Examiner's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ostrowski to include the missing claim limitation of claim 13. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

5. Examiner's reasoning for modifying Ostrowski to include the second missing claim limitation of claim 13 is insufficient to establish a *prima facie* case of obviousness.

³ For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would the secondary reference include it? The Examiner must explain the connection between the teachings of the primary reference and the rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Ostrowski does not teach "determining an overall score for the software product requirement from diagonal elements of the matrix P" as recited in claim 13. Office Action (7/25/2008), page 10. The Examiner's reasoning for modifying Ostrowski to include this missing claim limitation is "since the claimed invention is merely a combination of old elements, and a predictable result of this combination would have been giving the user of Ostrowski more options for determining scores depending on the user's particular needs." The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claim 13.

As indicated in M.P.E.P. §2143, the "combining prior art elements according to known methods to yield predictable results" rationale requires the Examiner to: (1) find that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) find that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in

combination, each element merely performs the same function as it does separately; (3) find that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Examiner has not made any findings that show that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Further, the Examiner has not made any findings to show that one of ordinary skill in the art could have combined the elements as claimed by known methods. Neither has the Examiner shown that each element merely performs the same function as it does separately. Additionally, the Examiner has not shown that one of ordinary skill in the art would have recognized that the results of the combination were predictable. Hence, the Examiner's rationale does not support a finding of a *prima facie* case of obviousness in rejecting claim 13.

Furthermore, the Examiner has not provided any rational underpinning as to how the Examiner derived his motivation for modifying Ostrowski to include the above-cited missing claim limitation. The Examiner simply states "since the claimed invention is merely a combination of old elements, and a predictable result of this combination would have been giving the user of Ostrowski more options for determining scores depending on the user's particular needs" as reasoning for modifying Ostrowski to include the above-cited claim limitation. While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Ostrowski to include the above-cited missing claim limitation. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). The Examiner appears to be relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's reasoning for modifying Ostrowski to include the missing claim limitation of claim 13 is insufficient to support a *prima facie* case of obviousness for

rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner's reasoning ("since the claimed invention is merely a combination of old elements, and a predictable result of this combination would have been giving the user of Ostrowski more options for determining scores depending on the user's particular needs") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ostrowski to include the above-indicated missing claim limitation of claim 13. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Ostrowski addresses improving the process in using the house of quality design process. Column 1, lines 19-32. The Examiner has not provided any reasons as to why one skilled in the art would modify Ostrowski (which improves the process in using the house of quality design process) to determine an overall score for the software product requirement from diagonal elements of the matrix P (missing claim limitation). The Examiner's rationale ("since the claimed invention is merely a combination of old elements, and a predictable result of this combination would have been giving the user of Ostrowski more options for determining scores depending on the user's particular needs") does not provide such reasoning.

Why would the reason to modify Ostrowski (whose purpose is to improve the process in using the house of quality design process) to determine an overall score for the software product requirement from diagonal elements of the matrix P (missing claim limitation) be to give the user more options for determining scores? Ostrowski is not concerned with having more options for determining scores. The Examiner cannot completely ignore the teachings of Ostrowski in concluding it would have been obvious to modify Ostrowski to include the missing claim limitation of claim 13.

Further, what is the rational connection between determining an overall score for the software product requirement from diagonal elements of the matrix P (missing claim limitation) and giving the user more options for determining scores (Examiner's reasoning)?

Hence, the Examiner's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Ostrowski to include the missing claim limitation of claim 13. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 13. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 9-16 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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